

Remarks/Arguments:

Claim 2, presented hereby in place of original claim 1, canceled hereby without prejudice or disclaimer, is pending.

Present claim 2 contains, essentially, the subject matter of original claim 1, revised to more clearly define the invention.

Claim 2 corresponds to claim 6 in parent application no. 09/831,377. Claim 6 was presented, but not entered, in the parent application. Entry of claim 6 was denied as defining non-elected subject matter. Accordingly, present claim 2 represents subject matter divided out of the parent application pursuant to restriction under 35 USC 121.

Claims in the parent application were rejected under 35 USC 102(b), or under 35 USC 103(a), based on either PL 102236 (abstract) or DE 3007850. As explained, below, none of the aforesaid rejections is applicable against present claim 2.

The presently claimed invention is concerned with the use of certain zinc alloys containing 8 to 15% by weight of aluminum and further alloy components for the preparation of strips and plates that can be used as constructional zinc, and which are prepared by the casting-and-rolling process.

Each prior art reference relied on, i.e., the abstract of PL 102,236 and DE 3,007,850, is concerned with other utilities of zinc than presently claimed and, therefore, should not be relevant, i.e., even if some of the alloy components in the references seem to be similar to those used in the present by claimed invention.

PL 102,236 is concerned with the thermomechanical treatment of a specific bearing zinc alloy to increase the dimensional stability and retain high abrasive-wear resistance. For that purpose, the castings are homogenized at 320-400 degree, then for one to fourteen hours air quenched to isothermal transformation at 200-700 degree, held 0.5-30 hours, hot rolled or extruded at 85-400 degree, annealed at 320-400 degree, for 1-12 hours air quenched to 200-270 degree, held 0.5-30 hours, hot rolled or extruded at 85-400 degree, annealed at 320-400 degree, for 1-12 hours air or water quenched to 80-280 degree, held 1-24 hours and aged at 70-160 degree for 2-96 hours. If formation is carried out in several stages, then interstage annealing at 180-400 degree for 0.25-10 hours and quenching are introduced. The improved properties of the alloy after the thermomechanical treatment are due to a high dispersion of Al and zinc phases attained during the treatment.

The aforesaid thermomechanical treatment produces something entirely different than constructional zinc of strips and plates prepared by the casting-and-rolling process that have, besides zinc, 8-15% of aluminum, 3-100 ppm of carbon, 2-500 ppm of vanadium, 2-500 ppm of silicon and optionally further components such as indium and/or calcium and/or magnesium. Further, this zinc alloy has to contain at least one component selected from the group consisting of 0.002-0.04% by weight of titanium, 3-100 ppm of boron, 3 to 50 ppm of magnesium, and a combination thereof.

DE 3007850 is concerned with use of a zinc alloy in the form of a powder for mechanical plating. There are a few examples of the alloy used that overlap with respect to aluminum as recited in the present claim. These examples, however, do not overlap with the other components of the

zinc alloy used according to the presently claimed invention. Plating with zinc powder or a zinc-alloy powder cannot be compared with the claimed method of the present invention, that is, the preparation of constructional zinc strips and plates by the casting-and-rolling process.

For anticipation under § 102 to exist, each and every claim limitation, as arranged in the claim, must be found in a single prior art reference. *Jamesbury Corp. v. Litton Industrial Products, Inc.*, 225 USPQ 253 (Fed. Cir. 1985). The absence from a prior art reference of a single claim limitation negates anticipation. *Kolster Speedsteel A B v. Crucible Inc.*, 230 USPQ 81 (Fed. Cir. 1986). A reference that discloses "substantially the same invention" is not an anticipation. *Jamesbury Corp.* To anticipate the claim, each claim limitation must "*identically* appear" in the reference disclosure. *Gechter v. Davidson*, 43 USPQ2d 1030, 1032 (Fed. Cir. 1997) (*emphasis added*). To be novelty defeating, a reference must put the public in possession of the identical invention claimed. *In re Donahue*, 226 USPQ 619 (Fed. Cir. 1985).

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). A "ground of rejection is simply inadequate on its face . . . [when] the cited references do not support each limitation of [the] claim." *In re Thrift*, 63 USPQ2d 2002, 2008 (Fed. Cir. 2002). When conducting an obviousness analysis, "all limitations of a claim must be considered in determining the claimed subject matter as is referred to in 35 U.S.C. 103 and it is error to ignore specific limitations

distinguishing over the [prior art] reference." *Ex parte Murphy*, 217 USPQ 479, 481 (PO Bd. App. 1982).

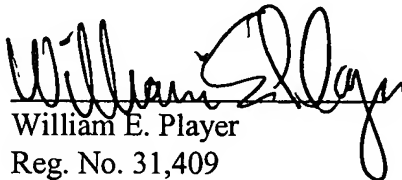
Neither cited reference describes or suggests "subjecting a zinc alloy to the casting-and-rolling process to prepare strips and plates as structural zinc" as presently claimed. Since each and every claim limitation, as arranged in the present claim, is not found any either one of the cited references, neither cited reference would support a rejection of present claim 2 under §102(b). *Jamesbury Corp., supra*. As all the claim limitations are not taught or suggested by either one of the cited references, neither cited reference would support an obviousness rejection of present claim 2 under §103(a). *Royka, supra*.

Favorable action is requested.

Respectfully submitted,

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